

Application No. 10/590,120
Amendment dated March 1, 2009
Reply to Office Action of October 1, 2008

Docket No.: 05581-00147-US

REMARKS

This Amendment is responsive to the Office Action dated mailed October 1, 2008. After its entry, claims 1-12, 14-22, and 24-33 are currently pending in this application and subject to examination. Claim 23 was cancelled in the Preliminary Amendment filed August 18, 2006. Claims 13 is cancelled. Claims 1-3, 6, 18, 24, 26, and 28 are amended. Support for these amendments is found at page 5, lines 7-12 and page 12, lines 16-23 of the present specification and in claims 13, 16, and 26, as originally filed. No new matter is added.

Reconsideration of the application as amended is respectfully requested in view of the following remarks.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 6, 28, and 31 stand rejected as indefinite.

Claim 6

The Examiner asserts that claim 6 is indefinite on the ground that it is “unclear what the covering layer contains at 0.05-0.25% by weight.” In response, Applicants have amended claim 6 to clarify that the covering layer contains *from 0.05 to 0.30 % by weight of mica*. Applicants submit that this amendment obviates the Examiner’s rejection and respectfully request its withdrawal.

Claim 28

The Examiner asserts that claim 28 is indefinite on the ground that it is “unclear what surface property is $1*10^{12}$ to $4*10^{12}$ Ohm/m².” In response, Applicants have amended claim 28 to clarify that the claimed film has a surface *resistance* of $1*10^{12}$ to $4*10^{12}$ Ohm/m².” Applicants submit that this amendment obviates the Examiner’s rejection and respectfully request its withdrawal.

Application No. 10/590,120
Amendment dated March 1, 2009
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Docket No.: 05581-00147-US

Claim 31

The Examiner asserts that claim 31 is indefinite on the ground that the term "COC" has not been defined in the specification or claims. Applicants respectfully traverse. It is well known to the skilled artisan that the term "COC" is the acronym for "cycloolefin copolymer." Furthermore, examples of what constitute cycloolefin copolymers are provided in the present specification at page 11, lines 23-25, by virtue of the specific reference to EP 1 385 899, the English-language equivalent of which is U.S. Patent No. 6,815,079 B2. In view of this, Applicants submit that claim 31 is not indefinite and respectfully request withdrawal of this rejection.

Rejection Under 35 U.S.C. § 103(a)

Claims 1-3, 6-14, 18-22, 24-27, and 30-33 stand rejected as obvious over U.S. Patent No. 6,544,607 to Kuroki et al (Kuroki). This rejection is moot as to claim 13, which is cancelled. Claims 4, 5, 15-17, 28, and 29 stand rejected as obvious over Kuroki in view of U.S. Patent No. 4,818,782 to Bissot (Bissot). Applicants respectfully traverse in view of the claims as amended.

Claims 1-3, 6-12, 14, 18-22, 24-27, and 30-33

Applicants submit that claims 1-3, 6-12, 14, 18-22, 24-27, and 30-33, as amended, are non-obvious over Kuroki.

Kuroki discloses an aliphatic polyester film comprising (A) a compound of formula (1):



wherein at least one R₁, R₂, and R₃ is an acyl group having 6 to 18 carbon atoms and the remaining groups are hydrogen or an acetyl group, and/or (B) a compound which is a reaction product of a condensate of 1 to 10 glycerin molecules with a carboxylic acid having 6 to 18 carbon atoms, wherein the aliphatic polyester may be, *inter alia*, polylactic acid-based. Column 2, lines 31-54 and lines 60-62. These films optionally contain additives, such as mica and glycerin monostearate, but Kuroki does not disclose the amount in which these additives are to

667428-1

Application No. 10/590,120
Amendment dated March 1, 2009
Reply to Office Action of October 1, 2008

Docket No.: 05581-00147-US

be incorporated. Column 6, lines 15-53 of Kuroki. Kuroki also discloses that additional films (*i.e.*, the “covering layer” referred to by the Examiner on page 3, paragraph 5 of the October 1, 2008 Office Action) are optionally formed on the surface of its aliphatic polyester films.

Column 8, lines 57-61. As such, the aliphatic polyester film of Kuroki would be the “base layer.” Kuroki does not disclose formation of these additional layers on its aliphatic polyester films via coextrusion. Column 8, line 61 to column 9, line 20 of Kuroki. Furthermore, none of the “covering” layers disclosed by Kuroki comprise any the components required by the covering layers recited in the present claims, nor does Kuroki disclose a thickness for its “covering layers.”

In contrast, the films of independent claims 1, 18, and 26 are *coextruded films* comprising, *inter alia*, a base layer and at least one covering layer. The *covering layer* of these films contain (1) at least one polymer of at least one aliphatic hydroxycarboxylic acid, (2) 1.5 to 10% by weight of a glycerine monofatty acid ester, and (3) up to 0.5% by weight of mica (claim 1), up to 2% by weight of mica (claim 18), or up to 0.3% by weight of wollastonite (claim 26). The thickness of the covering layer is from 0.5 to 6 μm .

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). As discussed *supra*, the “covering layer” of Kuroki does not contain *any* of the features required by the covering layer recited in claims 1, 18, and 26, nor does Kuroki disclose a multiple layer film comprising a base layer (*i.e.*, the aliphatic polyester film) and a “covering layer” formed via coextrusion, as required by claims 1, 18, and 26. Furthermore, if the Examiner were to treat the aliphatic polyester film of Kuroki as a “covering layer,” Applicants respectfully point out that Kuroki does not disclose the base layer, the amounts of glycerine monofatty acid ester, mica, or wollastonite, or the covering layer thickness required by claims 1, 18, and 26. Furthermore, Kuroki neither teaches nor suggests the application of its aliphatic polyester films to a base layer by coextrusion or any other technique.

Since Kuroki neither teaches nor suggests all of the limitations of amended claims 1, 18, and 26, this reference fails to render these claims *prima facie* obvious. Furthermore, since claims 667428-1

Application No. 10/590,120
Amendment dated March 1, 2009
Reply to Office Action of October 1, 2008

Docket No.: 05581-00147-US

2, 3, 6-12, 14, 19-22, 24, 25, 27, and 30-33 all depend directly or indirectly from amended claims 1 and 18, Kuroki likewise fails to render these dependent claims *prima facie* obvious. Applicants respectfully request withdrawal of this rejection.

Claims 4, 5, 15-17, 28, and 29

As discussed *supra*, Kuroki neither teaches nor suggests all of the limitations of amended claim 1. Claims 4, 5, 15-17, 28, and 29 all depend directly or indirectly from amended claim 1 and, thus, require all of its limitations. Bissot neither teaches nor suggests the features of claim 1 that Kuroki fails to teach or suggest. As such, the combined disclosures of these references neither teach nor suggest all of the limitations of claims 4, 5, 15-17, 28, and 29 and, thus, fail to render these claims *prima facie* obvious. Applicants respectfully request withdrawal of this rejection.

In view of the foregoing amendment and remarks, Applicants believe the pending application is in condition for allowance.

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Application No. 10/590,120
Amendment dated March 1, 2009
Reply to Office Action of October 1, 2008

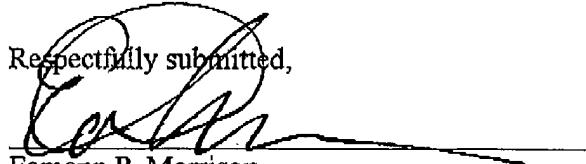
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Docket No.: 05581-00147-US

Filed concurrently herewith is a Petition Under 37 C.F.R. § 1.136(a) for a two-month extension of time. The Director is authorized to charge \$490.00 to Deposit Account No. 03-2775, under Order No. 05581-00147-US, to cover the two-month extension fee required by 37 C.F.R. § 1.17(a)(2). Should any other fees be required in connection with this Amendment, authorization is hereby made to charge any fees due or outstanding, including any extension fees, or credit any overpayment, to Deposit Account No. 03-2775, under Order No. 05581-00147-US, from which the undersigned is authorized to draw.

Dated: March 1, 2009

Respectfully submitted,



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667428-1